

Application No. 10/031,940
Attorney Docket No. PG3736USW

REMARKS

Currently Claims 1-4, 6-11, 13-18, and 21-62 are pending. All claims have been rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 99/06303 (hereinafter "Riebe") in view of U.S. Patent No. 5,772,085 to Bryant et al. (hereinafter "Bryant"). Applicant respectfully traverses this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.¹ M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. M.P.E.P. (citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness for at least the reason that there is no suggestion or motivation to combine the teachings of Riebe with the teachings of Bryant to provide a valve comprising, among other things, a sealing ring that includes a sealing portion and a wiper portion as recited in independent claims 1, 27, 38, 49, and 50. Riebe proposes a metering valve having a metering chamber (4) defined in part by an upper seal (12) and a lower seal (9). A dose of medication is dispensed from the metering chamber when the valve stem (7, 8) slides through seals (9 and 12). Thus, in Riebe, the seals are "stationary" and the valve stem slides through the "stationary" seals. In contrast, the sealing element in Figure 2d of Bryant is designed to surround the stem such that the stem and the seals move together rather than having the stem move through the seals (See Bryant, col. 6, line 17- col. 7, line 17). The Action contends

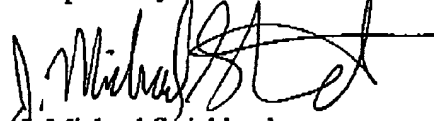
¹ Because all three criteria must be met in order to establish a *prima facie* case of obviousness, and the first criterion has not been met in that there is no motivation to combine Riebe with Bryant, Applicant addresses this first criterion without discussion of the other two criteria, namely whether there is a reasonable expectation of success and whether, if combined, the references teach all claim limitations. Applicant's decision not to discuss these other two criteria is in no way an acquiescence that these

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that it would be obvious to modify the "stationary" sealing rings of Riebe with the features of the "moving" seal element shown in Figure 2d of Bryant. Applicant respectfully submits that there is no motivation provided in Riebe or Bryant to make such a combination. In fact, even though Bryant itself proposes various valves having "stationary" seals (see, for example, col. 10, lines 10-39, describing the embodiment shown in Figure 5), Bryant does not provide any suggestion or motivation to use the features of the "moving" seal shown in Figure 2d on these or any other "stationary" seals. For at least the foregoing reasons, Applicant respectfully submits that claims 1-4, 6-11, 13-18, and 21-62 are patentable over Riebe in view of Bryant. Accordingly, Applicant respectfully request that these rejections be withdrawn and that a Notice of Allowance be issued forthwith.

If there are any outstanding issues following the entry of this Response, the Examiner is encouraged to contact the undersigned, who may be reached at (919) 483-9024.

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criteria have been proven by the Patent Office, and Applicant expressly reserves the right to address one or both of these criteria in future responses, should the need arise.